

REMARKS

By the present amendment, the title, the specification, and the abstract have been amended to correct “dendorimers” to “dendrimers.”

Accordingly, a substitute specification and abstract are submitted with this paper along with marked-up versions showing the changes made. The substitute specification and abstract are identical to the original specification and abstract except that each occurrence of “dendorimer” has been corrected to “dendrimer.” The substitute specification and abstract do not add any new matter.

Claims 1-20 are pending in the present application. Claim 1 is the only independent claim.

In the Office Action, claims 6, 7, and 9 are rejected under 35 U.S.C. 102(e) as anticipated by US2005/0287560 to Garimella et al. (“Garimella”).

The rejection is respectfully traversed. The present application was filed on August 26, 2003 and claims priority of JP2002-269867 filed on September 17, 2002. The subject matter of the present claims was disclosed in the priority application, as shown by the verified English translation of the priority application which is submitted with this paper.

Specifically, the subject matter of present claims 1-10 is disclosed for example in claims 1-10 of the priority JP’867 application, and the subject matter of present claims 11-20 is disclosed for example in claims 2 and in specification paragraph [0012] of the priority JP’867 application filed on September 17, 2002, as evidenced by the verified English translation.

Amendment
Serial No. 10/647,232
Attorney Docket No. 030980

In contrast, the Garimella application No. 11/124,609 is a continuation-in-part (CIP) filed on May 6, 2005 of a parent application No. 10/447,073 filed on May 28, 2003, which in turn is a continuation-in-part (CIP) of a grand-parent initial non-provisional application No. 10/194,138 filed on July 12, 2002. Further, the grand-parent '138 application claims priority of provisional applications No. 60/305,369 filed on July 13, 2001 and No. 60/363,472 filed on March 12, 2002, respectively, the parent '073 application claims priority of a provisional application No. 60/383,564 filed on May 28, 2002, and the '609 application claims priority of provisional applications No. 60/568,767 and No. 60/568,879 filed on May 6, 2004.

Thus, only the subject matter disclosed in the grand-parent '138 application to Garimella and the subject matter disclosed in the '564 provisional application to Garimella have an effective date under section 102(e) before September 17, 2002.

However, the grand-parent application US10/194,138, which was filed on July 12, 2002 and published on May 3, 2003 as US20030082588, does not disclose dendrimers. In particular, the word "dendrimer" is not used and branched molecules (such as those shown on Figs. 28-34 of the '609 application to Garimella) are not shown in the drawings of the grand-parent '138 application.

Thus, the disclosure in the grand-parent '138 application to Garimella is limited to covalent binding of molecules to a substrate. This is completely different from a dendrimer technology where a layer having a dendritic structure is important, and the number of optimum

lamination is differentiated depending on the types of biomolecules to be added, and hence it ranges from 2 to 10. Therefore, present claims 6, 7, and 9 are not anticipated by, and not obvious over, the subject matter disclosed in the grand-parent '138 application to Garimella.

Further, the Garimella provisional application No. 60/383,564 filed on May 28, 2002 is also silent regarding dendrimer technology. In particular, the word "dendrimer" is not used and branched molecules (such as those shown on Figs. 28-34 of the '609 application to Garimella) are not shown in the drawings. Therefore, present claims 6, 7, and 9 are not anticipated by, and not obvious over, the subject matter disclosed in the provisional '564 application to Garimella.

In summary, any dendrimer technology disclosure in the '609 application to Garimella (to which the Applicants make no admission) would not have an effective filing date under section 102(e) before September 17, 2002.

In view of the above, it is submitted that the rejection should be withdrawn.

In conclusion, the invention as presently claimed is patentable. It is believed that the claims are in allowable condition and a notice to that effect is earnestly requested.

If there is, in the Examiner's opinion, any outstanding issue and such issue may be resolved by means of a telephone interview, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number listed below.

Amendment
Serial No. 10/647,232
Attorney Docket No. 030980

If this paper is not considered to be timely filed, the Applicants hereby petition for an appropriate extension of the response period. Please charge the fee for such extension and any other fees which may be required to Deposit Account No. 50-2866.

Respectfully submitted,

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP



Nicolas E. Seckel
Attorney for Applicants
Reg. No. 44,373
Telephone: (202) 822-1100
Facsimile: (202) 822-1111

NES/rep